

REMARKS

I. Introduction

Claims 1 to 14 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested. Reference is made throughout the Amendment to a declaration by Dr. Harvey Levenson ("Levenson Declaration"), attached herewith, which supports a number of the arguments asserted by Applicants.

II. Rejection of Claims 1, 2, 5, 6 and 11 Under 35 U.S.C. §103(a)

Claims 1, 2, 5, 6 and 11 were rejected as unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 3,992,992 ("Smith") in combination with U.S. Patent No. 3,335,663 ("Harenza") and U.S. Patent No. 5,241,905 ("Guaraldi et al."). Applicants respectfully submit that the combination of Smith, Harenza and Guaraldi et al. does not render obvious claims 1, 2, 5, 6 and 11 for the following reasons.

Independent claim 1 relates to a lithographic newspaper printing press with at least one printing unit, the printing press printing a newspaper page. Claim 1 recites that the printing unit comprises a housing, having a first side wall and a second side wall, and a first and a second plate cylinder, each being rotatably mounted in the housing. Claim 1 further recites that the printing unit includes first and a second blanket cylinders, associated with the first and second plate cylinders, and an axially removable continuous blanket sleeve mounted on each of the first and second blanket cylinders. Claim 1 further recites that each of the first and second plate cylinders carries four flexible printing plates. Claim 1 further recites that the flexible printing plates are wrapped around the cylinders and are held by a plate lock-up mechanism, wherein the flexible printing plates are mounted on the first and second plate cylinders side by side. Claim 1 further recites that each of the first and second blanket cylinders have substantially the same diameter as the associated plate cylinder. Claim 1 further recites that each of the first and second blanket cylinders are cantilevered in the first side wall of the housing, when removing the continuous blanket sleeves from the first and second blanket cylinders. Claim 1 further recites that the length to diameter ratio of the first and second plate cylinders is in the range between 5.8 : 1 and 9 : 1. Claim 1 has been amended to recite that a width of the removable continuous blanket sleeve corresponds to at least that of the flexible printing plates mounted side-by-side. Support for this amendment can be found in the Specification, for example, p. 9, lines 11 to 13 and figure 5. Claim 1 has further been amended to recite that the plate cylinders having a length substantially four times the width of a flexible printing plate sized to carry a single newspaper page and having a circumference substantially equal to the height of the flexible printing plate, wherein each of the first and second plate cylinders carries four of the flexible printing plates. Support for this amendment can be found in original claims 1 and 4 and the Specification, for example, at

p.1, lines 16 to 19, p. 2, line 27, p. 3, lines 11 to 15, p. 3, line 27 to p. 4, line 2, p. 7, line 28 to p. 8, line 7 and p. 9, lines 24 to 29. Claim 4 has similarly been amended.

The Final Office Action alleges that Smith teaches a plate cylinder four pages wide and having four pages across, wherein each plate is the size of a page and that Harenza teaches a plate cylinder having four plates across and one plate around. The Final Office Action further alleges that Guaraldi et al. disclose a housing, sidewalls, first and second plate cylinders each having a plate lock-up mechanism, and first and second blanket cylinders each having an axially removable continuous blanket. The Final Office Action concludes that it would have been obvious to one of ordinary skill in the art to utilize the plate cylinder of Smith, as modified by Harenza, in the press of Guaraldi et al. to achieve well known benefits of blanket sleeves such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced. Applicants respectfully disagree for the reasons set forth below.

Smith purportedly relates to a dampener for a printing press. Smith states that the printing press includes a plate cylinder 10 adapted to carry four axially adjacent lithographic printing plates mounted about the peripheral surface thereof. See col. 2, lines 11 to 17. Smith does not disclose, or even suggest, a continuous blanket sleeve having a width corresponding to at least that of the flexible printing plates mounted side-by-side on the plate cylinder, as recited in amended claim 1. Smith makes no mention of a blanket sleeve, let alone one having a specific width.

Further, nowhere, does Smith disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a flexible printing plate sized to carry a single newspaper page, as recited in claim 1. Smith may disclose one "plate" around arrangement but not a one "page" around arrangement. There is a distinction between a "plate" and a "page." A one-around cylinder mounted plate may have more than one page mounted around its circumference depending on its height. In fact, one skilled in the art would recognize that at the time of Smith web offset printing press impositions for newspapers included at least two pages around the circumference of the plate. See Levenson Declaration at par. 7. Accordingly, disclosure by Smith of a one around plate in no way discloses, or even suggests, having the height of the plate sized to fit only one newspaper page, as recited in claim 1. Therefore, Smith does not disclose all of the limitations of claim 1.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." See M.P.E.P. § 2112 (emphasis in original); and see, Ex parte Levy, 17 U.S.P.Q.2d.1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case

law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The Final Office Action refers to the sentence bridging columns 1 and 2, column 2, lines 11 to 17 and column 3, lines 39 to 56 and alleges that Smith teaches a plate cylinder four pages wide and having four pages across, wherein each plate is the size of a page. See Final Office Action at p. 3. Applicants respectfully disagree and submit that nowhere does Smith state that each printing plate is sized to hold a single newspaper page, let alone does Smith state that each printing plate has the height of a newspaper page. The reference to a "double width, four page wide, rotary newspaper press," in the sentence bridging columns one and two, referenced by the Final Office Action, refers to the axial direction of the plate cylinder and, therefore, does not refer to the height of the printing plate. See Levenson Declaration at par. 7. One skilled in the art would recognize that at the time of Smith web offset printing press impositions for newspapers included at least two pages around the circumference of the printing plate. See Levenson Declaration at par. 7. Therefore, it is my opinion that the Smith web offset printing press imposition included at least two pages around the circumference of the printing plate.

The Final Office Action refers to col. 3, lines 50 to 51 and alleges that Smith discloses a "page size printing plate." Respectfully, the Final Office Action's reference to Smith is taken out of context. Smith states as follows:

As illustrated in FIG. 1, a series of four baffles 34, 35, 36 and 37 are employed each of which is substantially equivalent in width to the width of a page size printing plate and thus each baffle serves to meter the volume of dampening fluid to its respective plate.

Col. 3, lines 48 to 52. Applicants respectfully submit that Smith's use of the descriptor "page size" above in reference to the printing plate refers only to the width of the plate in the axial direction not the height. Clearly, in the above context, a plate having a multiple page height, for example, would still qualify as "page size" given that it would still be equivalent in width with each baffle. Reference to the plate as a "page sized printing plate" in the above excerpt, therefore, in now way indicates the height of the page. As indicated above, one skilled in the art would recognize that at the time of Smith, as well as at the time of filing of the present application, web offset printing press impositions for newspapers included at least two pages around the circumference of the plate. See Levenson Declaration at par. 7. Therefore, the above reference to Smith in now way affects the conclusion that the Smith web offset printing press imposition included at least two pages around the circumference of the printing plate.

Further, it is noted that the above sentence provides a description of the width of the four baffles 34, 35, 36 and 37. The sentence states that the baffles are equivalent in width to a page size printing plate. Smith uses a “page size printing plate” as a measure to describe the width of each baffle. Nowhere, however, does Smith disclose, or even suggest, that the actual printing plate to which dampening fluid is applied is single page sized.

Harenza purportedly relates to a printing press including a means for securing and registering thin printing plates on a cylinder driven in either direction. See col. 1, lines 9 to 12. The cylinder is stated to have a plate mounted “one around” and either two or four plates across extending the length of the cylinder. See col. 2, lines 34 to 38. Nowhere does Harenza disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. As indicated above, a one-around cylinder mounted plate may have more than one page mounted around its circumference depending on its height. In fact, one skilled in the art would recognize that at the time of Harenza, as well as at the time of filing of the present application, web offset printing press impositions for newspapers included at least two pages around the circumference of the plate. See Levenson Declaration at par. 9. Therefore, Harenza does not disclose all of the limitations of claim 1. Nor does Harenza cure the deficiencies of Smith. The Final Office Action alleges that Harenza teaches a plate cylinder having four plates across and one plate around. However, the Final Office Action does not even allege that Harenza discloses plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. Further, Harenza does not disclose, or even suggest, a blanket cylinder having at least the width of a four printing plates mounted side-by-side on the plate cylinder, as recited in amended claim 1.

Guaraldi et al. purportedly relate to a printing unit. Guaraldi et al. state that the printing unit includes upper and lower plate cylinders 14 and 18 and that a single printing plate is wrapped around each plate cylinder by locking mechanisms. See col. 2, lines 49 to 53. Respectfully, nowhere do Guaraldi et al. disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. In fact, one skilled in the art would recognize that at the time of Guaraldi et al., as well as at the time of filing of the present application, web offset printing press impositions for newspapers included at least two pages around the circumference of the plate. See Levenson Declaration at par. 10. Therefore, Guaraldi et al. do not cure the deficiencies of Smith and Harenza.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of Smith, Harenza and Guaraldi et al. does not disclose, or even suggest, all of the limitations of claim 1, including a plate cylinder having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page or a continuous blanket sleeve having a width corresponding to at least that of the four flexible printing plates mounted side-by-side on the plate cylinder, as recited in amended claim 1. Therefore, it is respectfully submitted that said combination does not render obvious claim 1.

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a §103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

The Final Office Action alleges that it would have been obvious to one of ordinary skill in the art to utilize the plate cylinder of Smith, as modified by Harenza, in the press of Guaraldi et al. to achieve well known benefits of blanket sleeves such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced. Applicants respectfully disagree for the following reasons.

First, Applicants submit that the above allegations are completely unsupported and are based on Applicants' own application. Specifically, Applicants' Specification states the following:

Having outlined the state of the art and its attendant disadvantages, it is an object of the present invention to provide a high-performance 8-page newspaper printing press for printing four newspaper pages across, which is small in size, light in weight and easily accessible, which can be operated with a small number of staff and which allows an easy and quick change of printing plates and printing blankets.

Specification at p. 2, lines 13 to 17. None of the patents relied upon mention or refer to the motivation alleged in the Final Office Action for making the proposed combination.

The apparent reliance on Applicants' Specification makes plain that the present rejection is based on nothing more than hindsight. As stated by the Federal Circuit in the case of In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999):

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of

ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . .Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . .Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight.

In re Dembiczak, 50 U.S.P.Q.2d at 1617 (citations omitted).

Further, Applicants respectfully traverse the Final Office Action's allegation that the benefits of blanket sleeves, such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced, are well known. It is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions.

Applicants further respectfully submit that it would not have been obvious to take a plate cylinder and its plate arrangement used in a 2:1 printing press, such as Smith¹ and Harenza², as suggested by the Final Office Action, and use it in a 1:1 printing press, such as Guaraldi et al. The relative size of the plate and blanket cylinders has a dramatic effect on the vibrations produced, and thus, on the overall functioning of the printing press. See Levenson Declaration at par. 14. Accordingly, the plate and blanket cylinders are necessarily designed as pairs. See Levenson Declaration at par. 14. Given this design reality, it would not have been obvious to mix and match pair elements, i.e., take the plate cylinder and plate arrangement alone from the 2:1 printing press of Smith or Harenza and use it to replace the plate cylinder and plate arrangement from the 1:1 printing press of Guaraldi et al. See

¹ Smith states that the printing press includes a plate cylinder 10 adapted to carry four axially adjacent lithographic printing plates mounted about the peripheral surface thereof. See col. 2, lines 11 to 17. Smith does not disclose a blanket cylinder, let alone the relative size of the plate and blanket cylinders. Given the time frame of Smith, however, it is known to one of ordinary skill in the art that blanket cylinders were clamped at their ends in relatively large grooves in the blanket cylinder, which generally required a 2:1 blanket cylinder to plate cylinders diameter ratio to dampen vibrations. See Levenson Declaration at par. 12. Given the above, one of ordinary skill in the art would recognize that Smith deals with 2:1 printing presses. See Levenson Declaration at par. 12.

² Harenza does not disclose a blanket cylinder or the relative size of the blanket cylinder to the plate cylinder. However, it is apparent to one of ordinary skill in the art that given the large vibration causing gap, required by the use of the two lock-up mechanism (see Figure 8), the blanket cylinders used with the plate cylinders generally would have a 2:1 diameter ratio; the larger blanket cylinders being used to dampen vibrations caused by the large gap in the plate cylinder. See Levenson Declaration at par. 13. Given the above, one of ordinary skill in the art would recognize that Harenza deals with 2:1 printing presses. See Levenson Declaration at par. 13.

Levenson Declaration at par. 14. This is especially so given, as indicated above, that the plate cylinder of Guaraldi et al. is stated to roll against a continuous, i.e., no gap, blanket cylinder and that, as one of ordinary skill in the art would recognize, the plate cylinders of Smith and Harenza roll against a blanket cylinder having a gap. See footnotes 1 and 2 as well as par. 14 of the Levenson Declaration.

The Advisory Action seems to allege that U.S. Patent No. 4,913,048 ("Tittgemeyer") provides a motivation for combining Smith, Harenza and Guaraldi et al. Tittgemeyer purportedly relates to a method and apparatus for printing with a lithographic sleeve. Respectfully, Tittgemeyer does not remedy the above noted deficiencies of Smith and Harenza. More specifically, Tittgemeyer does not disclose, or even suggest, a plate cylinder having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page or a continuous blanket sleeve having a width corresponding to at least that of the four flexible printing plates mounted side-by-side on the plate cylinder, as recited in amended claim 1. Further, and more generally, Tittgemeyer also does not teach using a plate cylinder and plate arrangement from a 2:1 printing press on a 1:1 printing press nor does Tittgemeyer provide any motivation for reducing the plate cylinder from two or more pages around to one page around. See Levenson Declaration at par. 15.

The Final Office Action further alleges that Guaraldi et al. teach continuous blanket cylinders. Applicants submit that even given the existence of the continuous, and thus gapless, blanket of Guaraldi et al. it would not have been obvious to use a 1:1 plate cylinder and blanket cylinder pair; wherein the plates mounted on the plate cylinder are sized to carry a single newspaper page, as recited in claim 1. Further, Applicants respectfully submit that one of ordinary skill in the art would not have found it obvious to have reduced the diameter of the plate cylinder to one page around, as claimed in claim 1, given the expected increase in vibrations, which is an undesirable side effect. The increased vibrations would have been expected when reducing the diameter of the printing cylinder due to the resulting decrease in plate cylinder stiffness and the increase in cylinder revolutions per given period of time. Further, a reduction in diameter decreases the number of pages printed per unit time without a corresponding increase in rotational speed, which as indicated above contributes to increased vibrations. See Levenson Declaration at paragraphs 18 and 19. Applicants have discovered, however, that when the plate and blanket cylinders have a 1:1 diameter ratio the cylinders have a thinner line of contact, which results in an increase in nip pressure and allows for reduced diameters without increased vibration. Therefore, Applicants submit that claim 1 is patentable over the combination of Smith, Harenza and Guaraldi et al. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 1.

As for claims 2, 5, 6, and 11, which depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that the combination of Smith,

Harenza and Guaraldi et al. does not render obvious these claims for at least the same reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 2, 5, 6 and 11.

III. Rejection of Claims 3 and 4 Under 35 U.S.C. §103(a)

Claims 3 and 4 were rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and EP 644,048 (“Schneider et al.”). Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and Schneider et al. does not render obvious claims 3 and 4 for the following reasons.

Applicants respectfully submit that Schneider et al. do not cure the deficiencies of Smith or Harenza and Guaraldi et al. Specifically, Schneider et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. Schneider et al. do not disclose a one page around cylinder. In fact, nowhere do Schneider et al. refer either directly or indirectly to plate imposition. Nor does the Examiner rely on Schneider to remedy said deficiencies. Claims 3 and 4 depend from claim 1 and therefore include all of the limitations of claim 1. Accordingly, Applicants submit that claims 3 and 4 are patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 3 and 4.

Regarding claim 4, Applicants submit the following additional reasons in support of patentability. Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and Schneider et al. does not disclose that each of the plate cylinders has a circumferential register adjustment system configured to provide circumferential register adjustment to its respective plate cylinder, as recited in claim 4. The Final Office Action at p. 3 refers Applicants to the following excerpt from Harenza:

Still another object of the present invention is to provide a plate lockup for a reversible cylinder which includes a novel means for effecting peripheral and axial adjustment of a printing plate at the leading edge position regardless of direction of rotation.

Col. 1, lines 55 to 59 (emphasis added). However, the above reference discusses a means for adjusting a printing plate not a plate cylinder, as recited in claim 4. See Levenson Declaration at par. 16. In this regard, the Specification states as follows:

As it can be further be seen from Fig. 2 and Fig. 3, in the preferred embodiment of the invention, each of the printing couples formed of the first and second plate cylinders 24a, 24b and its associated blanket cylinders 12a, 12b is driven by a separate motor 26. Alternatively, the plate and blanket cylinders 24a, 24b and 10a, 10b can also be driven by a common drive shaft. In order to provide for a circumferential register adjustment of the first and second plate cylinders 24a, 24b there can be provided a respective circumferential adjustment apparatus 27, e.g., in [the] form of a known harmonic drive coupled to the drive shaft of each of the first and/or second plate cylinder 24a, 24b.

Specification at p. 9, lines 11 to 19 (emphasis added). Therefore, Applicants submit that the combination of Smith, Harenza, Guaraldi et al. and Schneider et al. does not render obvious amended claim 4.

IV. Rejection of Claim 7 Under 35 U.S.C. §103(a)

Claim 7 was rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and U.S. Patent No. 5,152,222 (“Okamura et al.”). Applicants submit that Okamura et al. do not cure the deficiencies of Smith, Harenza and Guaraldi et al. Specifically, Okamura et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. Nor does the Examiner rely on Okamura et al. to remedy said deficiencies. Claim 7 depends from claim 1 and therefore includes all of the limitations of claim 1. Accordingly, Applicants submit that claim 7 is patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 7.

V. Rejection of Claims 8 to 10, 13 and 14 Under 35 U.S.C. §103(a)

Claims 8 to 10, 13 and 14 were rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al., Okamura et al. and U.S. Patent No. 5,617,788 (“Horiguchi et al.”). Applicants submit that Horiguchi et al. do not cure the above noted deficiencies of Smith, Harenza, Guaraldi et al. and Okamura et al. Specifically, Horiguchi et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. Nor does the Examiner rely on Horiguchi et al. to remedy said deficiencies. Claims 8 to 10, 13 and 14 ultimately depend from claim 1 and therefore include all of the limitations of claim 1. Accordingly, Applicants submit that claims 8 to 10, 13 and 14 are patentable for at least the reasons provided above in support of the

patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 8 to 10, 13 and 14.

VI. Rejection of Claim 12 Under 35 U.S.C. §103(a)

Claim 12 was rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and “applicant's admission of prior art.” Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and “applicant's admission of prior art” does not render obvious claim 12 for the following reasons.

As an initial matter, in addressing the merits of this rejection, Applicants do not concede the correctness of the Final Office Action's characterization of the subject matter on page 4 of the Specification as prior art, but will proceed, for the sake of argument only, on the premise that the Final Office Action's characterization is accurate. Therefore, when framed accordingly, Applicants' argument is that even if the Final Office Action is correct in characterizing page 4 of the Specification as prior art, the invention of claim 12 would still be patentable over such alleged admitted prior art.

Applicants submit that the alleged admitted prior art does not cure the deficiencies of Smith, Harenza and Guaraldi et al. Specifically, the alleged admitted prior art does not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a printing plate sized to carry a single newspaper page, as recited in claim 1. Nor does the Examiner rely on “applicant's admission of prior art” to remedy said deficiencies. Claim 12 depends from claim 1 and therefore includes all of the limitations of claim 1. Accordingly, Applicants submit that claim 12 is patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 12.

VII. Nonstatutory Double Patenting Rejection of Claims 1 to 14

Claims 1 to 14 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 12 of U.S. Patent No. 6,374,731. The Final Office Action indicates, however, that a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome this rejection. Applicants will prepare a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome the nonstatutory double patenting rejections of claims 1 to 14 upon withdrawal of all other rejections and/or when the claims are indicated to be in final form for allowance. Accordingly, an indication that all of the pending claims are allowable post filing of a terminal disclaimer is respectfully requested.

VIII. Conclusion

It is therefore respectfully submitted that the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: January 26, 2005

By: 

Abraham P. Ronai

Reg. No. 41,275

One Broadway

New York, New York 10004

(212) 908 - 6408

CUSTOMER NO. 26646